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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,104	11/15/2000	Eiichi Sato	B422-143	9652
26272	7590	09/06/2007		
COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER MOORTHY, ARAVIND K	
			ART UNIT 2131	PAPER NUMBER
			MAIL DATE 09/06/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/713,104		SATO, EIICHI	
	<b>Examiner</b>		<b>Art Unit</b>	
	Aravind K. Moorthy		2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is in response to the amendment filed on 11 June 2007.
2. Claims 25-28 are pending in the application.
3. Claims 25-28 have been rejected.
4. Claims 1-24 have been cancelled.

#### ***Response to Amendment***

5. The examiner approves of the amendment made to claims 25, 27 and 28. The applicant has cancelled the limitation "a transmission step of transmitting a message that received image data is stored in said storage area, to the destination of the received image data". With the cancelled limitation, the claim no longer has any issues under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner withdraws the rejection.

#### ***Response to Arguments***

6. The indicated allowability of claims 25-28 is withdrawn in view of the newly discovered reference(s) to Diamant et al. Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**7. Claims 25, 27 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Diamant et al U.S. Patent No. 5,969,632.**

As to claim 25, Diamant et al discloses a communication apparatus for transferring data from a first network to a second network, the apparatus comprising:

a first discrimination unit configured to discriminate if the received data is a confidential data [column 8, lines 44-51];

a judgment unit configured to judge if the transfer path to the destination of the received data is secure or not, when the result of the discrimination by the first discrimination unit indicates the received data is a confidential data [column 10, lines 37-41]; and

a storage unit configured to store the received data, when the result of the judgment by the judgment unit indicates the transfer path is not secure [column 10, lines 47-59].

As to claim 27, Diamant et al discloses a control method for a communication apparatus for transferring data from a first network to a second network, the method comprising:

a first discrimination step of discriminating if the received data is a confidential data [column 8, lines 44-51];

a judgment step of judging if the transfer path to the destination of the received data is secure or not, when the result of the discrimination in the first

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discrimination step indicates the received data is a confidential data [column 10, lines 37-41]; and

a storage step of storing the received data, when the result of the judgment in the judgment step indicates the transfer path is not secure [column 10, lines 47-59].

As to claim 28, Diamant et al discloses a storage medium computer-readably storing a program for causing a computer to execute a control method for a communication apparatus for transferring data from a first network to a second network, the method comprising:

a first discrimination step of discriminating if the received data is a confidential data [column 8, lines 44-51];

a judgment step of judging if the transfer path to the destination of the received data is secure or not, when the result of the discrimination in the first discrimination step indicates the received data is a confidential data [column 10, lines 37-41]; and

a storage step of storing the received data, when the result of the judgment in the judgment step indicates the transfer path is not secure [column 10, lines 47-59].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Diamant et al U.S. Patent No. 5,969,632 as applied to claim 25 above, and further in view of Applied Cryptography (hereinafter Schneier).**

As to claim 26, Diamant et al discloses an apparatus, further comprising;

management unit configured to manage address of a transmission destination in relation with whether there exists a key [column 17, lines 27-36];

second discrimination unit configured to discriminate whether there exists the key related to the address of the transmission destination, if the judgment unit judges that the transfer path is not secure [column 10, lines 37-41];

encrypting unit configured to encrypt the received data, if the second discrimination unit discriminates that there exists the key [column 15, lines 47-59]; and

transmission unit configured to transmit the received data encrypted by the encrypting unit to the transmission destination [column 15, lines 47-59].

Diamant et al does not teach that the key is a public key [pages 4-5].

Schneier teaches the use and benefits of using public key cryptography.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Diamant et al so that the management unit would have been configured to manage address of a transmission destination in relation with whether there exists a public key. The second discrimination unit would have been configured to discriminate whether there exists the public key related to the address of the transmission destination, if the judgment unit judges that the transfer path was not secure. The encrypting unit would have been configured to encrypt the received data, if the second discrimination unit discriminates that there existed the key. The transmission unit would have been configured to transmit the received data encrypted by the encrypting unit to the transmission destination.


It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Diamant et al by the teaching of Schneier because it provides the extra security because it only allows a specific person with the corresponding decryption key to decrypt the data pages 4-5].


***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aravind K Moorthy   
August 30, 2007

  
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